

REMARKS

The last Office Action has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 8-13, 15-20 and 22-38 are currently pending. The Examiner has withdrawn the restriction requirement with respect to SEQ ID NO 5, 7 and 8. Claims 25-28, 31-34 and 37-38 were withdrawn as directed to non-elected species. However, since the Examiner has withdrawn the restriction as to these SEQ ID NOS, the Examiner is respectfully requested to now examine claims 25, 27, 31, 32, 37 and 38.

Claims 8-12, 22-24, 29, 30, 35 and 36 were examined.

The Examiner has withdrawn the rejection to the specification relating to paragraph [00125].

The Examiner's rejection based on 35 U.S.C. § 102(b) as being anticipated by Khan has been rendered moot.

The rejections under on 35 U.S.C. § 103(a) as being obvious over Khan and Schirmbeck has been rendered moot; likewise the rejection under 35 U.S.C. § 103(a) as being obvious over Khan, Schirmbeck Shiver, Laprevotte and Genbank accession and Gardner-Arnstein codon usage.

As to the Examiner's objection as to formal matters, applicant herewith provides the CRF sequence listing again in txt form. The references to the SEQ ID NOS now appears in proper form to avoid the objection; the rendition "shown in" has been replaced by "as set forth" as requested by the Examiner. Claim 24 has been cancelled in response to the Examiner's objection. The numbering of claims has been corrected.

Claims 8-12, 22, 35 and 36 are rejected under 35 U.S.C. § 112, second paragraph as failing to particularly pointing out and distinctly claiming the subject matter, applicant regards as the invention.

With respect to claim 22, the Examiner pointed out that the metes and bounds of the claim are not determined.

With respect to claim 36, the Examiner objected to the lack of antecedent basis for "the gag coding sequence" and "the same sequence".

The Examiner currently rejected claim 23 and 36 under 35 USC § 102(b) as anticipated by WO9215672 to Paoletti ("Paoletti") as evidenced by the publication Progr. Nucleic Acid Res. Mol. Biol. 11: 259-301, 1971 paragraph bridging pages 260-261 by Kennel ("Kennel").

The Examiner states specifically that SEQ ID NO 5 is free of prior art.

Claims 22-23, 25, 29, 30-34 and 37-38 have been amended. Claims 24, 26 and 28 are cancelled. New claims 39 and 40 are presented.

Record is also made of a telephonic interview between the Examiner and applicant's representative which took place on September 15, 2009.

The Examiner is thanked for her help and assistance as well as for the courtesies extended to Counsel at that time. During the course of the interview the present application was extensively discussed, and as a result, applicant now submits this amendment to place the application in formal condition for allowance.

During the interview claims 23 and 36 were discussed to elucidate the rejections thereof. While applicant acknowledged the rejection of claim 36 without any admission as to propriety, the rejection of claim 23 remains in error since the SEQ ID NO 5 was specifically determined by the Examiner as being free of prior art, therefore claim 23 should have allowed. It appears not sound reasoning to reject claim 23 because claim 36 was rejected. Applicant agreed to name the primers as per the Examiner's suggestion.

Claim 22 was discussed and it was proposed to the Examiner to change the expression "and/or" to "or" only in order to overcome the rejection. The Examiner did state any agreement without having seen claim 22.

The Paoletti/Kennel rejection was also discussed, wherein applicant representative objected the 35 U.S.C. § 102(b) rejection that was based on more than one reference, otherwise it is not an anticipation rejection and that the references to the Paoletti reference as stated on page 6 of the office action was

not understood. In particular, the reference to Result 5 SCORE Search Result Details is not understood. Furthermore, applicant stated that a homology of about 50% does not amount to anticipation.

While the Examiner agreed that claim 23 should be allowable, as to any other issues, the Examiner reserved decision pending the written submission.

REJECTION UNDER 35 U.S.C. § 102(B)

With respect the rejected claims 23 and 36, applicant asserts that claim 23 is allowable based on the Examiner's determination that SEQ ID NO 5 is without prior art.

Claim 36 was amended to recite the specific primers used and to delete reference to SEQ ID NO 5. Support for the primers are found in the specification in Example 7 on page 27.

With respect to the anticipation rejection on the basis of Paoletti as evidenced by Kennel, applicant contends that the rejection is improper in that the rejection must be based on only one reference.

The sequence similarity of 52.7 % in Paoletti between the two DNA sequences was used by the Examiner for an anticipation rejection. Applicant submits that the percentage as stated does not amount to an anticipatory similarity since approximately 50% represents barely a relationship in the field of molecular biology. A similarity of about 50% is likely to be found in the genomes between homo sapiens and a rain worm.

On page 6 of the Office Action, the Examiner asserts:

"To the extent that new claims 23 and 36 drawn to nucleotides that read on fragments of domains of SEQ ID NO 5 with *any percentage of homology*, the following rejection..... "

It is unclear to applicant what the Examiner refers to here. Claim 23 is directed to a specified sequence and does not encompass nucleic acid molecules *with any percentage homology*.

The Kennel reference the Examiner cited is directed to thermal stability of reassociation of DNA strands and has nothing to do with the present invention.

It is believed that by the foregoing amendment and discussion, the rejection of claim 36 as being anticipated by Paoletti should be withdrawn. Claim 23 should be allowable as per the Examiners' statement.

Withdrawal of the rejection of claims 23 and 36 under 35 U.S.C. § 102(b) and allowance thereof is respectfully requested.

REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 22 was amended to overcome the rejection. In particular, applicant has deleted the reference to "at least of [gag] and [env]" to read "one of [gag] or [env]". The disjunctive is believed to remedy the rejection in that the reference to that last part of the claim where a Markush grouping now provides the selection between SEQ ID NOS 5, 7 and 8.

The remaining rejection with respect to claim 36 have become moot by deleting the offending language. In particular, "the "gag" sequence" refers to SEQ ID NO 5 and is therefore considered proper with a definite article.

Since claim 22 has been amended to overcome the rejection, the rejection of claims 8-12 and 15 is believed likewise to be overcome thereby.

Withdrawal of the rejection of claims 8-12, 15, 35 and 36 under 35 U.S.C. § 112, second paragraph and allowance thereof is respectfully requested.

MISCELLANEOUS STATEMENT

The information recorded in computer readable form is identical to the content of the paper sequence listing submitted herewith in CRF form.

CONCLUSION

Applicant believes that when reconsidering the claims in the light of the above comments, the Examiner will agree that the invention is in no way properly met or anticipated or even suggested by any of the references however they are considered.

None of the references discloses a method as claimed to provide a vaccine for cats with modified "gag" and "env" genes as claimed.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are thus respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

By: 
Ursula B. Day
Attorney for Applicant
Reg. No. 47,296

Date: October 2, 2009
708 Third Avenue
Suite 1501
New York, N.Y. 10017
(212) 244-5500
UBD:sh